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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,733

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Christine Wild

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7590 12/29/2009
SYNNESTVEDT & LECHNER LLP
SUITE 2600 ARAMARK TOWER
1101 MARKET STREET
PHILADELPHIA, PA 19107

EXAMINER

AHMED, HASAN SYED

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

12/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/517,733

Applicant(s)

WILD ET AL.

Examiner

HASAN S. AHMED

Art Unit

1615

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-35 is/are pending in the application.
- 4a) Of the above claim(s) 21, 29 and 33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-20, 22-28, 30-32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of applicants' remarks filed on 23 September 2009. The arguments regarding the obviousness-type double patenting rejection in said remarks are persuasive.

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16, 17, 22-27, 30, 34, and 35 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,749,860 ("Tyrrell").

Tyrrell teaches an absorbent article comprising:

- the synthetic waxes of instant claim 16(a) (see col. 5, lines 30-48);
- the alkoxyated derivatives of fatty acid esters of instant claim 16(b) (see col. 7, lines 4-19);
- the polymeric waxes of instant claim 16(c) (see col. 12, lines 45-54);
- the melting point of instant claim 17 (see col. 7, line 24);
- the melting point of instant claim 24 (see col. 11, line 53);
- the silicone wax of instant claim 25 (see col. 28, line 10);
- the skincare substances of instant claim 26 (see col. 29, line 53 - col. 30, line 17);

- the water of instant claims 27 and 35 (see col. 51, line 1); and
- the polyethylene nonwoven of instant claim 30 (see col. 25, line 19);

Tyrrell explains that the disclosed composition is beneficial because it has improved transfer from the bodyfacing materials of disposable absorbent articles to the skin (see col. 1, lines 18-21).

While Tyrrell does not explicitly teach the polyvinyl stearyl ether of instant claim 22, the polyoxyethylene stearyl ether disclosed by Tyrrell (see col. 8, lines 44-45) is deemed to be its functional equivalent, since both are polyethylene stearyl ethers.

While Tyrrell does not explicitly teach the percentages of instant claims 16, 23, 25-27, or 35, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose a composition comprising synthetic waxes, alkoxylated

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derivatives of fatty alcohols, and polymeric waxes, as taught by Tyrrell. One of ordinary skill in the art at the time the invention was made would have been motivated to make such a composition because it has improved transfer from the bodyfacing materials of disposable absorbent articles to the skin, as explained by Tyrrelle.

*

Claims 16, 18, 19, 20, 28, 31, and 32 remain rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,749,860 ("Tyrrell") in view of U.S. Application No. 2002/0058916 ("Hisanaka").

Tyrrell teaches an absorbent article (*see above*).

Tyrrell differs from the instant application in that it does not disclose the fatty acid glycerides of instant claims 18, 19, 31, and 32 or the coconut fatty acid esters of instant claims 20 and 28. However use of these compounds in compositions that are solid at 21°C were known at the time the instant application was filed, as evinced by Hisanaka (*see paragraph 0040*).

While Hisanaka does not explicitly teach the percentages of instant claim 28, it would have been obvious to one of ordinary skill in the art at the time the invention was made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the

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prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose a composition comprising fatty acid glycerides, esters of coconut fatty acids, and polymeric waxes, as taught by Tyrrell in view of Hisanaka. One of ordinary skill in the art at the time the invention was made would have been motivated to make such a composition because it has improved transfer from the bodyfacing materials of disposable absorbent articles to the skin, as explained by Tyrrelle.

* * * * *

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 16-20, 22-28, and 30-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-52 of copending Application No. 10/458,651 ('651). Although the conflicting claims are not identical, they are not patentably distinct from each other because '651 teaches a composition comprising synthetic waxes, alkoxyated derivatives of fatty alcohols, and polymeric waxes (see claim 1).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

* * * * *

Response to Arguments

Applicants' arguments filed on 18 August 2008 have been fully considered but they are not persuasive.

Applicants argue that the rejection selects members from long lists of optional ingredients (see remarks, pages 2-3).

Examiner respectfully submits that Tyrell teaches the ingredients being claimed in a non-aqueous composition. The disclosure of Tyrell shows that the composition being claimed instantly has been contemplated in the prior art. Furthermore, the selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). MPEP 2144.07.

Applicants argue that the combination of Tyrell and Hisanaka is improper (see remarks, page 3).

Examiner respectfully submits that In response to applicants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Tyrell and Hisanaka are relate to the same field of endeavor, i.e., absorbent articles.

Applicants argue that there is no support for the amounts and melting points being claimed to be a matter of routine experimentation (see remarks, page 3).

Regarding melting points, examiner respectfully submits that the cited prior art teaches the same compounds being claimed. As such, the melting point is an inherent property of the compound. Regarding amounts, applicants are claiming broad ranges and have not shown criticality of the claimed ranges.

★

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

★

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HASAN S. AHMED whose telephone number is (571)272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571)272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. S. A./
Examiner, Art Unit 1615

/Humera N. Sheikh/
Primary Examiner, Art Unit 1615